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[10191/1690]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : BECKER et al.
Serial No. : 09/762,985
Filed : May 8, 2001
For : DEVICE AND METHOD FOR ETCHING A SUBSTRATE
USING AN INDUCTIVELY COUPLED PLASMA
Examiner : L. Alejandro
Art Unit : 1763
Assistant Commissioner
for Patents
Washington, D.C. 20231

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Dated: 1/16/03

Reg. 41,172

Signature

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ELECTION WITH TRAVERSE

SIR:

In response to the restriction requirement dated
September 25, 2002, Applicants elect, with traverse, the claims
of Group II, namely, claims 42-60.

REMARKS

Before turning to the merits of this restriction
requirement, Applicants note that the Examiner has considered
the wrong set of claims because claims 1-27 were canceled by the
Preliminary Amendment that accompanied the national stage
filing. The restriction should have been based on new claims
31-60, which were introduced by this Preliminary Amendment. The
restriction divides the original claims into method and
device claims and requires election between the two sets. The
new set of claims also is dividable between device and method
claims. On the assumption that the Examiner would have made the
same type of device/method claim restriction had claims 31-60
been considered, Applicants wish to elect, with traverse, the
method claims that are currently pending, namely, claims 42-60.

Nevertheless, Applicants traverse the restriction
requirement because under Rule 475, Applicants are entitled to

have all of claims 12-22 examined by the Patent Office in this application. Rule 475(b) reads, in pertinent part, as follows:

An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

(4) A process and an apparatus or means specifically designed for carrying out the said process....

(Emphasis added). According to the cited portion of Rule 475, if the claims are directed only to a "process" and "an apparatus or means specifically designed for carrying out the said process", the Patent Office must, not may, treat the application as having unity invention. The Patent Office has no discretion in this matter, since the Rule specifically states that if the national stage application satisfies one of the conditions in Rule 475(b), the "national stage application ... will be considered to have unity of invention."

In this application, Applicants submit that Rule 475(b)(4) is satisfied. According to the MPEP,

An apparatus or means is specifically designed for carrying out the process when the apparatus or means is suitable for carrying out the process with the technical relationship being present between the claimed apparatus or means and the claimed process. The expression specifically designed does not imply that the apparatus or means could not be used for carrying out another process, nor does it imply that the process could not be carried out using an alternative apparatus or means.

MPEP at § 1893.03(d). Both claim 31 and claim 42 relate to etching a silicon body substrate. Thus, because this feature is common to both the process and apparatus claims, the device recited in claim 31 is suitable for carrying out the process of claim 42. Since this is true, Rule 475 mandates that the Patent Office consider the claims in this application to have unity of invention, regardless of the particular justification set forth by the Examiner in the restriction. Accordingly,

withdrawal of this restriction requirement is respectfully requested.

Respectfully submitted,

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Dated: 1/16/03

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